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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/299,068	04/23/99	WILLIAMSON	W 25932-5

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EXAMINER

MEDLEY, M  
ART UNIT PAPER NUMBER

1714  
DATE MAILED:

04/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/299,068

Applicant(s)

WILLIAMSON et al

Examiner

MEDLEY

Group Art Unit

1714

☒ Responsive to communication(s) filed on 3-14-00

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-35 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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The species election is withdrawn in view of Applicants specie election to (TM-TO), maleic anhydride and sorbitol (wherein it is unclear that the (TM\_TO) is the first moiety of the structure) and the rejections set forth below.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-35 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-35 of copending Application No. 09/234,019. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urushibata et al 5,304,316 in view of Funahashi et al 4,696,869 and Lindemann 3,322,703.

Urushibata prepare reaction compounds and disclose processes for preparing said reaction compounds comprising reacting a mixture of (A) alkylene oxide ester and (B) an incomplete ester of a polyhydric alcohol reacted with an alkylene oxide and a fatty acid with a dicarboxylic acid or an anhydride thereof which rendered obvious the claimed friction reducing compounds and processes for producing said compounds, note the abstract, column 2, lines 48-60; column 3, lines 6-21 and 58 to column 6, line 55. These components of the prior art reaction are the same components designed first moiety, second moiety and third moiety of the instant claims.

Applicants claimed compounds and processes differ from that of the prior art in that the instant claimed compounds are claimed as friction reducing compounds (anti-wear compounds) and esterification at from about 220<sup>0</sup> C to about 320<sup>0</sup>C and with an acid catalyst. It is the Examiner's position that the friction reducing properties (anti wear properties) of Urushibata compounds and processes are obvious because a newly disclosed property does not necessarily mean the product is unobvious, since this property may be inherent in the prior art. In re Best 195 USPQ 430; In re Swinehart 169 USPQ 226. When the prior art and applicant both describe processes which are indistinguishable, then the products may also be assumed to be inherently

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indistinguishable. In re Myers 159 USPQ 339 (1968). The burden is shifted to Applicants to show product differences in product by process claims. In re Best 195 USPQ 430 (CCPA 1977); In re Brown 173 USPQ 685; In re Fessman 180, USPQ 324.

The examiner's position is that Urushibata et al, esterification temperature range of 80<sup>0</sup> - 200<sup>0</sup> C rendered obvious Applicants claimed esterification range of from about 220<sup>0</sup> C to about 320<sup>0</sup> C. Lindemann teachings incorporated in Urushibata at column 6 provide the teachings and motivation for using an acid catalyst in Urishibata esterification process, note column 10, lines 6-7. It is the examiner's position that Urushibata's generic disclosure renders the Applicants' claimed species prima facie obvious. Funahashi, note column 1, line 44 to column 2 lines 1-47, teaches ester derived from polyvalent alcohols and acids that encompasses Applicants reactants. Urushibata further provides the motivation to substitute one polyhydroxy for another, one acid for another and one unsaturated synthetic dieneophilic base oil for another. A generic disclosure renders a claimed species prima facie obvious. Ex parte George 21 USPQ 2d 1057, 1060 (BPAI 1991); In re Woodruff 16 USPQ 2d 1934; Merck & Co. v. Biocraft Lab. Inc. 10 USPQ 2d 1843 (Fed. Cir. 1983); In re Susi 169 USPQ 423 (CCPA 1971).

Claims 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urushibata et al 5,304,316 in view of Funabashi et al 4,696,869 and Lindemann, 3,322,703 as applied to claims 1-19 above, and further in view of 4,601,840 Zehler.

Urushibata et al fail to disclose or suggest their reactive products as an additive for an anti-friction (anti-wear) supplement composition and as a friction (anti-wear) modifier in a crank

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case oil formulation comprising a phosphorous additive, optionally an EP additive, a VI, an anti-oxidant, a pour depressant, a dispersant, a detergent and a base oil carrier.

Zehler teaches and discloses a lubricant composition comprising a base oil carrier and other conventional additives and a non-phosphorous friction modifier compound when a technical grade PE is reacted with an acid mixture.. Note abstract, column 5, line 39 to column 6, lines 1-52, column 8, line 61 to col. 9, line 64 and Example 8 of column 15. For the usually percentage of the conventional additives, note column 13 lines 40-48 rendering the claimed percentage of the conventional additives obvious. Zehler provides the motivation for using Urushibata additive reaction product in a lubricant composition wherein their reaction product is rendered obvious by Urushibata et al product modified with the secondary references.

Claims 1-8 and 11-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayahai 4,489,194, 4,509,955 and 4,486,573.

Patentees disclose and teach reaction additives, process for producing said additives, reaction additive supplemental composition lubricant composition comprising said additive which render obvious applicants claimed reaction products, method for producing the same, additive package and lubricant composition containing the same, note '194 abstract, column 3, line 20 to column 4, lines 1-2 and 67 to column 5, line 42, column 8, lines 40-48; column 16, lines 22-53, column 21, lines 5-56, column 24, lines 4 to end, column 25 lines 21-29, Examples 9 and 15, column 29 line 65 to column 30 lines 1-14, column 35 line 49 to column 36, lines 1-40 and claims 1, 3-12, 24 and 37; '955 abstract, column 3, line 34 to column 4, lines 1-5; column 5, lines 17-59;

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column 8, lines 45-52; column 16, lines 29-60; column 21, lines 13-66; column 24, line 12 to column 25 lines 1-2, 29-37, column 26, lines 21-38; column 27, line 47 to column 28, lines 1-9, column 30, line 59 to end; column 31, lines 25-64 and claims 1-8 and 14; and '573 abstract, column 3, lines 17 - end, column 4, line 65 to column 5, line 39, column 7, line 67 to column 8, lines 1-7, column 15, line 49 to column 16, lines 1-12, column 20, line 32 to column 21 lines 1-15, column 23, line 33 to column 24, lines 1-13 and 49-61, column 26, lines 1-37, column 27, line 46 to column 28, lines 1-8, column 31, lines 3-42 and claims 1, 3-16 and 28.

Claims 1-6, 11-16 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer Re 32,174.

Le Suer teaches and discloses reaction additives, process for producing said additive and concentrate composition containing said additives with conventional additives that render obvious applicants' claims, note abstract, column 1, line 45-61, column 2, lines 54-65, column 3, lines 19-30 and 60 to column 4, lines 1-19, column 7, lines 19 to column 8, lines 1-25 and 48-51, column 10, lines 55 to end and Table 1 Examples 13, 14, 16, 18 and 19.

It is the Examiner position that Applicants intended use of the supplemental composition is of no consequence because intended use of composition is not patentably significant. In re Heck 114 USPQ 161 (CCPA 1957). With respect to the claimed anti-friction (anti-wear) properties, the Office position is that a newly is discovered property does not necessarily mean that the product is unobvious, since this property may be inherent in the prior art. In re Best 195 USPQ 430; In re Swinehart 169 USPQ 226.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 and 11-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Baillargen et al 5,284,496.

Baillargen et al disclose and teach additives, the process for making said additives, the process for making said additives and additives concentrates for distillate fuels which anticipate or in the alternative render obvious the claims.. The additives are polyesters and modified polyester polymers derived from the reaction of (1) anhydrides or acid equivalents, (2) epoxides or diol equivalents and (3) a reactive material, e.g. epoxidized fatty ester, polyols, etc. which are the same components designed (a) a first moiety, an unsaturated synthetic dieneophilic base oil; (b) a second moiety, a compound having a diene conjugated carbon - carbon double bond and a carboxylic acid moiety or anhydride group; and (3) a third moiety of a polyhydroxy compound,. note column 1, line 44 to column 2, line 24, 29-34 and 43-47; column 3 line 36 to column 4, lines 1-61; column 6, lines 22-31 and column 7-8 and 13 for Tables 1 and 2 for entry 140 and 141 and the claims wherein applicant can substitute the diol equivalent of Vikolox 18 to render obvious the additives.

Applicants claimed additives, method for making said additives and additive concentrates differ from that of the prior art in that the instant claimed additive, method and additive



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concentrates are disclosed as anti-friction (anti-wear) compounds or as an anti-friction (anti-wear) supplemental composition for addition to lubricant formulations. It is the Examine position that the substitution of one polyhydroxy for another and the substitution of the diol equivalents for the epoxy alkane render obvious the claimed reaction product and process. The prior art concentrate containing the reaction products render obvious applicants claimed anti-friction supplement composition because the claimed lower limit of "0%" phosphorus additive, EP additive and solubility stabilizer read on the said components not being present nor required in the composition.

The examiner takes the position that the claimed additives, process and composition having friction reducing (anti-wear) properties considered by applicants to be a newly discovered property does not mean the product is unobvious, since this property may be inherent in the prior art. In re Best 195 USPQ 430; In re Swinehart 169 USPQ 226.

Applicants intend their claimed anti-friction (anti-wear) supplement composition for addition to lubricant formulas. Likewise the intended use of a composition is not patentably significant. In re Heck 114 USPQ 161 (CCPA 1957).

Claims 1-6 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipate by Le Suer Re 32,174, Note Table 1 of columns 9-10 for Example 14.

Claim 28 is objected to because of the following informalities: The term "anti-oxidant" should be corrected for, its spelling. Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase in lines 3-5 is considered as containing matter that was not described in the specification

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite and confusing for the line containing 'lubricity additive' that is not set forth in claim 1, lines 2-3 "first moiety", ... consisting of in order" because it is unclear as to which moiety in line 2 that the compounds of lines 3-5 are related. Claim 10 is further indefinite for the last two component because it is unclear how the ethylene diamine can be a polyhydroxy compound. Clarification is requested.

The references cited but not applied further teach lubricant oil compositions comprising additives of the same nature.


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Any inquiry concerning this communication should be directed to Margaret B. Medley at telephone number (703) 308-2518.

Margaret B. Medley/om  
April 25, 2000

  
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